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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,676	07/26/2005	Jorgen Bodum	26648U	6934

20529 7590 06/27/2006

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112 South West Street
Alexandria, VA 22314

EXAMINER

ROST, ANDREW J

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.		Applicant(s)	
	10/530,676		BODUM, JORGEN	
	Examiner		Art Unit	
	Andrew J. Rost		3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| <ul style="list-style-type: none"> 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date <u>7/26/2005</u>. | <ul style="list-style-type: none"> 4) <input type="checkbox"/> Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____. |
|--|--|

DETAILED ACTION

1. This action is in response to the Preliminary Amendment filed 4/08/2005. No claims were cancelled. No claims were added. Claims 3, 4, and 6-15 were amended. Presently, claims 1-15 are pending.

Specification

2. The disclosure contains the following informalities:

Reference number 8 refers to both a "connection port" (paragraph 0026, line 2) and a "take-out port" (paragraph 0028, line 3).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 1, line 6, refers to "an at least occasionally liquid demanding device" (line 6), and refers to "being opened by means in the device" (page 2, line 3) which render the claim indefinite.

Claim 1, lines 11-12 recites the limitation "the flow passage". There is insufficient antecedent basis for this limitation in the claim.

Claim 2, lines 5-7 recites the limitation "which is distinctly superior to the force produced by the sealing or positioning to the prism or cylinder" is not clearly defined and renders the claim indefinite.

Claim 7, lines 2-3 recites the limitation "the valve part". There is insufficient antecedent basis for this limitation in the claim.

Claim 8, lines 3-4 recites the limitation "means of the valve for opening of the take-out valve is being controllable" renders the claim indefinite because it is unclear to the examiner as to how the device is being controllable.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required

feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 7 recites the broad recitation flexible, and the claim also recites preferably elastic which is the narrower statement of the range/limitation.

In the present instance, claim 9 recites the broad recitation supporting, and the claim also recites preferably tubular which is the narrower statement of the range/limitation.

In the present instance, claim 10 recites the broad recitation molding, and the claim also recites preferably injection molding which is the narrower statement of the range/limitation.

In the present instance, claim 13 recites the broad recitation "drinkable water", and the claim also recites "preferably mineral drinking water" which is the narrower statement of the range/limitation.

In the present instance, claim 14 recites the broad recitation "a bottle", and the claim also recites preferably "transparent of plastic material" and further "preferably approved for use with human food" which is the narrower statement of the range/limitation.

In the present instance, claim 15 recites the broad recitation "an espresso machine", and the claim also recites "preferably designed as a domestic appliance" which is the narrower statement of the range/limitation.

Claims 13-15 provide for the use of an adapter, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 13-15 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 14 recites the use of an adapter with "the container being a bottle". It is apparent the applicant is claiming a specific container but it appears to the examiner that the bottle is not part of applicant's invention of an adapter.

Claim 15 recites the use of an adapter with "the device being an espresso machine". It is apparent the applicant is claiming a specific device but it appears to the examiner that the specific device is not part of applicant's invention of an adapter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 2 (as best understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over You (5,785,076) in view of Pauliukonis (4,033,378).

Regarding claim 1, as best understood, You discloses an adapter that connects a container (hose connected to adapter opposite 21), a device (tire, not shown, that requires air for inflation), a first valve (44) between an attachment port (13) and a connection means (21) with the first valve being biased closed by a spring (45) with the connection means being shaped as a cylindrical port and a second valve (23) being placed in the adapter to be operated by a device. You does not disclose the second valve being spring biased. However, Pauliukonis teaches the placement of a spring (30) to bias a valve to a closed position in order to insure that only cylinder pressure holds valve shut and sealed and that the spring adds little to the end force required for valve operation in service (col. 2, lines 59-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to spring bias the second valve of You closed as taught by Pauliukonis in order to insure that only cylinder pressure holds the valve shut and sealed and that the spring adds little to the end force required for valve operation in service.

In regards to claim 2, the modified You reference discloses the adapter remaining connected to the container (hose) when removed from the device (shown connected in Fig. 2).

7. Claims 3-12, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over You in view of Pauliukonis as applied to claims 1 and 2 above, and further in view of Robinette (4,168,015).

In regards to claim 3, You in view of Pauliukonis disclose an adapter connecting a container and a device with the adapter having first and second valves both being spring biased. The modified You reference does not disclose the attachment means having an elastomer. However, Robinette teaches the placement of an elastomeric packing ring (27) between the wall of an adapter and the wall of a container in order to provide a sealing contact between the surfaces (col. 2, lines 8-10). Therefore, it would have been obvious to place an elastomer between the attachment port and container of the modified You reference as taught by Robinette in order to provide a sealing contact between the surfaces.

In regards to claims 4 and 5, the modified You reference discloses the attachment port shaped as a truncated cone (as shown in Fig. 1, cone is 13) with the cone having ribs and grooves (ribs are the expanded portions with the grooves being the recessed portions as shown in Fig. 1) with the cone tapering away from the adapter body.

In regards to claims 6 and 7, the modified You reference discloses the first valve is upstream from the attachment port and is biased by a spring (45) into a closed position with the first valve being operable to adjust the flow through the adapter (col. 4, lines 1-3).

In regards to claim 8, the modified You reference discloses the opening of the valve is controlled by the device (col. 3, lines 36-39).

In regards to claim 9, the modified You reference discloses an elastic packing ring being formed as a sleeve (Fig. 2 of Robinette reference)

In regards to claims 10-12, the modified You reference discloses an adapter having a linear passage between an attachment port and connecting means with the attachment port being contained within an outlet of the container. Regarding the claimed limitation of the adapter being shaped by molding, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113).

Conclusion

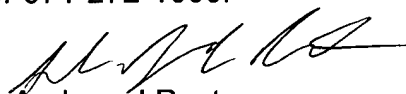
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kaufman (2,545,233) disclose a pressure check valve for use in filling a container. Kolodie (2,550,825) discloses an adapter connected to a bottle having a spring biased valve.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Rost whose telephone number is 571-272-2711. The examiner can normally be reached on 7:30-5 M-Th and 7:30-5 every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3751

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew J Rost
Examiner
Art Unit 3751



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6/21/06